

REMARKS

The claims 1-19 are pending with claims 5-19 added by this amendment. Support for these claims may be found at pages 3-5 and 8-9 of the present specification.

Claim Rejections Under 35 U.S.C. §102(b)

Claim 1 stands rejected as allegedly anticipated by U.S. Pat. No. 5,300,358 (Evers). Applicants respectfully traverse this rejection.

Evers discloses:

Compostible and flushable non-rigid, highly absorbent structures, particularly for sanitary uses for the absorption of body fluids, comprising an absorbent degradable fibrous core and a **backsheet** that is cold-water soluble but water repellent on the inner and outer sides.

Column 2, lines 33-37, emphasis added. Particularly, Evers discloses that:

In another aspect of the invention, a surfactant is used to increase the rate of water solubility of the backsheet of the present articles. **For example, soluble degradable synthetic backsheet of a diaper of the invention may be coated with a fluorochemical repellent**; after use, the repellent can be wetted with the assistance of a fluoro-surfactant such as "ZONYL" FSO. **The surfactant, put in the disposal water, reduces the surface tension of the repellent layer, which in turn permits the degradable backsheet to be dissolved rapidly in the cold water.** Sufficient concentration of surfactant decreases the advancing contact angle to less than 70°.

In this embodiment of the invention, the fluorochemical repellent does not permit the backsheet to be wet by an assaulting liquid until the fluorochemical repellent is contacted with the surfactant. **Therefore, for disposal of absorbent structures like diapers via the toilet, the toilet water dissolves the backsheet, the segments of the core break-up into flushable size pieces, and the top sheet is flushed to enter a degradable environment.**

Column 7, lines 47-66, emphasis added.

However, to anticipate a claim, the reference must teach every element of the claim. Evers

teaches a diaper backsheet coated with a fluorochemical repellent. Evers utterly fails to teach or suggest a resist composition, comprising a fluorochemical surfactant, coated onto a substrate. As such, there is no *prima facie* case of anticipation, and Applicants respectfully submit that the rejection should be withdrawn.

Claim Rejections Under 35 U.S.C. §103

Claims 2 and 3 stand rejected as allegedly unpatentable over Evers, as applied to claim 1. The Action admits that Evers does not disclose the specific surfactant formula claimed by Applicant. However, the Action alleges that Applicants disclose commercially available surfactants, *e.g.* fluorochemical surfactants under the trade name of KH-10, KH-20, KH-30 and KH-40, and thus, the use of these surfactants would be obvious to one skilled in the art at the time of the invention. Applicants respectfully traverse these rejections.

The anticipation rejection to claim 1 has been discussed above. But not only does Evers not anticipate claim 1, Evers cannot render claim 1 obvious because to establish *prima facie* obviousness of a claimed invention, all claim features must be taught or suggested by the prior art. As discussed above, Evers utterly fails to teach or suggest a resist composition, comprising a fluorochemical surfactant, coated onto a substrate. Applicants respectfully submit that the term resist composition in the preamble should be given full patentable weight at least due to its recitation in the body of the claim. Moreover, the Action has failed to suggest any desirability for one of ordinary skill in the art to modify a backsheet of a diaper into a resist composition coated onto a substrate. As such, there is no *prima facie* case of obviousness with respect to claim 1. Because claims 2 and 3 depend from claim 1, claims 2 and 3 are patentable at least due to their dependency to claim 1.

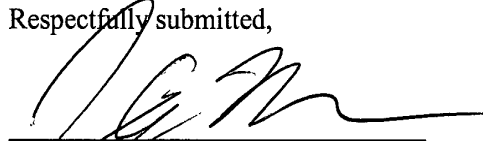
Supererogatorily, although fluorochemical surfactants under the trade name of KH-10, KH-20, KH-30 and KH-40 are commercially available, the Action has utterly failed to establish any desirability for one of skill in the art to modify a resist composition to comprise a fluorochemical surfactant.

As such, there is no *prima facie* case of obviousness and the rejections to the claims should be withdrawn. Applicants respectfully withhold commenting on claim 3 as not to burden the record. However, Applicants respectfully reserve the right to provide further comments on the utter

unobviousness of any and all of the self-explanatory dependent claims, if ever necessary.

In view of the above remarks, favorable reconsideration is courteously requested. If there are any remaining issues which can be expedited by a telephone conference, the Examiner is courteously invited to telephone Counsel at the number indicated below.

Respectfully submitted,



James E. Kuland
Registration No. 37,432

Millen, White, Zelano and Branigan
Arlington Courthouse Plaza
2200 Clarendon Blvd.
Suite 1400
Arlington, VA 22201
(703) 812-5338 [Direct Dial]
(703) 243-6410 [Facsimile]
Internet Address: ruland@mwzb.com

Filed: October 5, 2001

JER:\\BART\\CLIENTS\\KOJIM\\289\\AMENDMENT AND RESPONSE 10-01.DOC